UNITED STATES PATENT AND TRADEMARK OFFICE

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10/774,877	02/10/2004	Todd Simpson	87239/00004	8796

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EXAMINER
CHANKONG, DOHM

ART UNIT	PAPER NUMBER
2452	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/774,877	SIMPSON, TODD
	Examiner	Art Unit	
	DOHM CHANKONG	2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 June 2009</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>14-56</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>14-56</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

DETAILED ACTION

This action is in response to Applicant's amendments and arguments filed on 6/9/2009.

Claims 14, 18, 24, 37, 47, and 52 are amended. Claims 1-13 were previously canceled.

Accordingly, claims 14-56 are presented for further examination.

This action is a final rejection.

Specification

A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(c)

because a clean version without markings was not provided with the amended specification

submitted on 8/1/2006. *See* 37 C.F.R. § 1.125(c) ("An accompanying clean version (*without*

markings) and a statement that the substitute specification contains no new matter must also be

supplied."). The amended specification purports to amend specification submitted on 2/10/2004.

However, the amended specification relies on paragraph numbers while old specification does

not.

For example, page four of the amended specification describes inserting "new paragraph

12" and "new paragraphs 21-23." However, the old specification does not describe paragraphs

13-20. These paragraphs are therefore missing entirely from the specification. Similar remarks

apply to paragraphs 1-4, 27, 32, 35, 37-41, 44, and 47.

The specification is also objected to as failing to provide proper antecedent basis for the

claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the

following is required: claims 14 and 24 recite a "storage module" and "storage device." These terms lack proper antecedent basis because they are not described in Applicant's specification.

Response to Arguments

§ 101 rejection of claims 14 and 24

In response to the § 101 rejection of claims 14 and 24 and the examiner's suggestion, Applicant has amended the claims to include a "storage module" and "storage device" respectively. These terms are not defined in Applicant's specification and therefore cannot properly be interpreted to determine whether they overcome the § 101 rejection of claims 14 and 26 for being directed to software *per se*. The terms are therefore objected to for lacking proper antecedent basis in the specification.

Applicant also argues that the claimed system "includes a communication link between the sender subsystem and receiver subsystem." The examiner agrees that if the claimed system of claims 14 and 24 included a "communication link," the system would be statutory. However, claim 14 merely recites that the subsystem be "in data communication with the sender subsystem." Claim 24 lacks any limitation related to a communication link between the subsystems. The phrase should be amended to recite that the system comprises a communication link which links the two subsystems.

Finally, Applicant argues that the subsystems are "automated systems" which imply that the subsystem are a combination of software and hardware. This argument is not persuasive for two reasons. First, the claims do no require interpreting the subsystem as an "automated system" since the term "automated" is not in the claim.

Second, simply because software is "automated" does not mean that it must be interpreted

with hardware. For example, a calendar function in an email program may be "automated" to

send out notifications every Monday. In that example, while being "automated," the calendar

function is software *per se*.

In conclusion, to overcome the § 101, the claims should be amended, *consistent with*

Applicant's specification, to include language that requires interpreting the system as a machine.

The examiner suggests amending the claims such that the system includes a communication link

to achieve this goal.

§ 112 rejection of claims 14, 24, 37, 47, and 52

The examiner had relied on the specification provided in Applicant's printed publication

2004|0199593 which is different from the specification submitted on 8/1/2006. As noted in the

foregoing specification objection, the examiner does not have a clean and complete specification

with Applicant's amended language. After considering the amended specification, the examiner

withdraws the § 112 rejection.

§ 103 rejection

Applicant argues that *Gross* fails to teach the claimed invention because *Gross* does not

disclose a receiver subsystem that permits new categories to be added by a sender subsystem.

According to Applicant, *Gross* discloses "a human operator" that is accepting or rejecting

suggestions from "another human operator." Applicant also argues that *Gross'* processing

criteria are not the same as a category assigned to a message that classifies the category to which

the message belongs. Applicant's arguments are not persuasive.

As to Applicant's second argument, *Gross* explicitly teaches "[t]he restricted availability of tags and the selection of tags by a sender enables messages to be appropriately processed [where] *[p]rocessing includes, but is not limited to categorization of messages* in accordance with predetermined criteria" (emphasis added) [0010]. This disclosure clearly states that the tags are used to categorize messages. Thus, it is reasonable to infer that the suggestion of a new tag effectively suggests a new categorization for a message.

As to Applicant's first argument, Applicant is arguing limitations not in the claim. Applicant's argument implies that there is no user interaction with the subsystem. However, the claims do not require this interpretation. For example, there is no language stating that the subsystems act independently of a user, automatically, without user input, or any other phrase that would suggest that the subsystem is automated.

Moreover, Applicant's specification states that the negotiation process may be configured so as to "allow a user's participation in the negotiation of categorization" [Amended specification (8/1/2006), pg. 10, para. 45]. Applicant's printed publication states "Jane also has a "(New)" category, meaning that she is willing to negotiate (*herself or through her agent*) a new category for this sender" [20040199593, 0031].

Because they are written broadly, Applicant's claims may be interpreted according to either of these cited embodiments (with or without user's participation in the negotiation). *Gross'* teaching of using a receiver and sender to suggest new categories read on the embodiment of a user participating in the negotiation of the categories as described in Applicant's specification.

As the claims are currently written, *Gross* teaches that a sender proposes new categories

and a receiver accepts or rejects suggestions through the use of an email program [Fig. 1 «item

12» | 0263]. The email program may be interpreted as Applicant's claimed subsystems.

Applicant is advised to amend the claims to more clearly define which embodiment of the

negotiation process is being claimed.

Conclusion

Based on the foregoing, Applicant's arguments with respect to the § 101 and § 103

rejections are not persuasive. Those rejections are maintained in this action. Applicant's

arguments with respect to the § 112 rejection are persuasive and therefore that rejection is

withdrawn.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claims 14-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter. The current position of the Patent Office in regard to statutory

inventions under 35 U.S.C §101 for software claims is that software *per se* does not fall into any

of the statutory categories. That is, software *per se* is neither a process, a machine, a

manufacture, or a composition of matter.

Independent claim 14 is directed to "an e-mail system" that comprises a sender subsystem

and a receiver subsystem. Based on the claim language and Applicant's specification, a

subsystem may still be interpreted as software. Thus, claim 14 is directed merely to software *per*

se and do not contain subject matter that falls within a statutory category. Thus, claim 14 is

rejected under 35 U.S.C §101 as failing to fall within a statutory category. As to claims 15-23,

they do not cure any of above cited deficiencies of claim 14 and are therefore rejected for at least

the same reasons set forth for claim 14.

Independent claim 24 is directed to a system that comprises a negotiation module that

includes both the sender and receiver subsystem. For the same reasons discussed with respect to

claim 14, claim 24 is also rejected under 35 U.S.C. §101 as failing to fall within a statutory

category. As to claims 25-36, they do not cure any of the above cited deficiencies of claim 24

and therefore are rejected for at least the same reasons set forth for claim 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

**I.   CLAIMS 14-17, 20-43, AND 47-56 ARE REJECTED UNDER 35 U.S.C. §103(A) AS BEING
UNPATENTABLE OVER *SCHIAVONE* ET AL, U.S PATENT PUBLICATION NO. 2002|0120600
["*SCHIAVONE*"], IN VIEW OF *GROSS* ET AL, U.S PATENT PUBLICATION NO. 20040111478
["*GROSS*"].**

All citations are to *Schiavone* unless otherwise noted.

Claims 14, 37, and 52

As to claim 14, *Schiavone* as modified by *Gross* discloses an e-mail system for

exchanging messages among users of the system, the system comprising:

a sender subsystem for transmitting a message from a sender to a receiver, the sender

subsystem having access to a list of categories [0062 : *Schiavone*'s mailing software 170 reads

on Applicant's claimed sender subsystem | 0026 : senders "share knowledge of a common set of

message type specifiers" where *Schiavone*'s specifier reads on Applicant's claimed category];

and

a receiver subsystem for receiving the message, the receiver subsystem being in data

communication with the sender subsystem [0064 : the "recipient's communication device 150"

reads on Applicant's claimed receiver subsystem | 0026];

wherein the receiver subsystem is configured to permit the sender subsystem to propose

new categories for adding to a listing of receiver categories [*Gross,* 0263: sender making

suggestions to the receiver], and

wherein the sender subsystem is configured to identify a category for the message based

on the listing of categories [0035 | 0062 : receiver sharing knowledge with the mailing software

and the mailing software selecting a mail-type specifier based on a list of shared specifiers], to

initiate a categorization negotiation process with the receiver subsystem [0051: negotiating the

delivery of the email messages], that includes at least the steps of communicating the category to

the receiver subsystem [*Gross,* 0263], receiving an indication from the receiver subsystem

whether the category is recognized by the receiver subsystem and adopting the category as a

negotiated category if the category is acceptable or, if the category is not acceptable, negotiating

with the receiver subsystem by proposing an alternative category to the receiver subsystem and

adopting the alternative category as the negotiated category if the alternative category is

acceptable to the receiver subsystem [*Gross,* 0263: receiver may accept or reject the proposed

category, 0268: sending an indication to the sender to recategorize a message according to newly

accepted categories], to associate the negotiated category with the message [*Gross*, 0046, 0263,

0268], and to transmit the categorized message to the receiver subsystem [0062-0064].

As indicated above, *Schiavone* does not expressly disclose that receiver subsystem is

configured to permit the sender subsystem to propose new categories for adding to a listing of

receiver categories or the feature of proposing an alternative category to the receiver subsystem

if the category is not acceptable. However, these features were well known in the art at the time

of Applicant's invention. *Gross* is directed towards a system in which users identify how

messages are to be processed using categorization techniques [0013]. *Gross* further discloses

permitting the sender subsystem to propose new categories for adding to a listing of receiver

categories [0263], proposing an alternative category if the category is not acceptable [0046,

0268], and a sender subsystem associating a category with a message upon receiving an

indication that a receiver subsystem recognizes the category [0046: the receiver-approved tags

are transmitted to the sender as the sender composes the message | 0263 | 0268].

It would have been obvious to one of ordinary skill in the art to have modified

Schiavone's system for negotiating email transactions to have included *Gross*' teachings.

Specifically, one would have been motivated to include the feature of enabling a receiver to

either accept or reject sender-proposed categories into *Schiavone*'s negotiations functionality.

Such a feature improves *Schiavone*'s system because in allowing a receiver to restrict the

distribution of the categories, messages may be appropriately categorized and processed

according to the receiver's control [see *Gross*, 0044].

As to claims 37 and 52, as they do not teach or further define over the limitations of claim 14, claims 37 and 52 are rejected for at least the same reasons set forth for claim 14.

Claims 15 and 38

As to claim 15, *Schiavone* discloses the recognized category is identical to a receiver category [0062 : "list of shared specifiers"]. As to claim 38, as it does not teach or further define over the limitations of claim 15, claim 38 is rejected for at least the same reasons set forth for claim 15.

Claims 16, 17, 40, 41, and 53

As to claim 16, *Schiavone* discloses the recognized category is mapped from a receiver category [0062 : negotiated specifier is selected from the list].

As to claim 17, *Schiavone* discloses the recognized category is a new category added to a listing of receiver categories [0025 : *Schiavone* discloses scanning the text of the message and creating a new specifier based on the text of the message. Thus, the specifier is newly added. Also see *Gross*, 0261].

As to claim 40, as it does not teach or further define over the limitations of claim 16, claim 40 is rejected for at least the same reasons set forth for claim 16. As to claims 41 and 53, as they do not teach or further define over the limitations of claims 16 and 17, claims 41 and 53 are rejected for at least the same reasons set forth for claims 16 and 17.

Claims 20, 21, and 42

As to claim 20, *Schiavone* discloses an intermediary subsystem, wherein the listing of categories is provided to the sender subsystem through the intermediary subsystem [0026].

As to claim 21, *Schiavone* does not expressly disclose that the listing of categories is a union of a first listing provided by the intermediary subsystem and a second listing provided by the sender subsystem. However, *Schiavone* does disclose that the listing of categories is a result of shared "knowledge of a common set of message type specifiers" [0026]. The term "common set" is well known to refer to a set of items in common between two different sets. Thus, it would have been obvious for one of ordinary skill in the art to have reasonably inferred from *Schiavone*'s use of the term "common set" that the listing of categories was a result of a union of message type specifiers provided by the sender and the third party.

As to claim 42, as it does not teach or further define over the limitations of claims 20 and 21, claim 42 is rejected for at least the same reasons set forth for claims 20 and 21.

Claim 22

Schiavone does not expressly disclose a sender intermediary subsystem for communicating with said intermediary subsystem to negotiate said category. However, the concept of distributing different functionalities between different network elements, such as from a sender to a sender's intermediary, is well known and obvious. *Schiavone* does disclose that his system can be implemented by spreading out different functionalities to multiple third party intermediaries [0066]. Thus, it would have been obvious to one of ordinary skill in the art to have implemented *Schiavone* with a sender intermediary subsystem to perform the sender's responsibilities.

Claims 23, 39, and 54

As to claim 23, *Schiavone* discloses a user interface for presenting the listing of categories to the sender subsystem to select the category therefrom [0025 : specify a mail type

specifier by selection from a menu]. As to claims 39 and 54, as they do not teach or further

define over the limitations of claim 23, claims 39 and 54 are rejected for at least the same

reasons set forth for claim 23.

Claim 24

Schiavone discloses a system for classifying messages transmitted by a message

exchange system, the message exchange system including a sending subsystem for transmitting a

message from a sender to a receiver and a receiving subsystem for receiving the message, the

system comprising:

a negotiation module, the negotiation module maintaining a listing of categories [0064 :

Schiavone's trust authority 200 reads on a negotiation module];

said negotiation module including a sender subsystem for initiating negotiation of a

category and a receiver subsystem for providing the sender subsystem with an indication whether

the category is acceptable to the receiver system [*Gross*, 0263, 0268],

wherein the receiver subsystem is configured to permit the sender subsystem to propose

new categories for adding to a listing of receiver categories [*Gross,* 0263: sender making

suggestions to the receiver], and

wherein the sender subsystem is configured to identify a category for the message based

on the listing of categories [0035 | 0062 : receiver sharing knowledge with the mailing software

and the mailing software selecting a mail-type specifier based on a list of shared specifiers], to

initiate a categorization negotiation process with the receiver subsystem [0051: negotiating the

delivery of the email messages], that includes at least the steps of communicating the category to

the receiver subsystem [*Gross,* 0263], receiving an indication from the receiver subsystem

whether the category is recognized by the receiver subsystem and adopting the category as a

negotiated category if the category is acceptable or, if the category is not acceptable, negotiating

with the receiver subsystem by proposing an alternative category to the receiver subsystem and

adopting the alternative category as the negotiated category if the alternative category is

acceptable to the receiver subsystem [*Gross,* 0263: receiver may accept or reject the proposed

category, 0268: sending an indication to the sender to recategorize a message according to newly

accepted categories], to associate the negotiated category with the message [*Gross*, 0046, 0263,

0268. See the rejection of claim 14 for reasons to modify *Schiavone* to include *Gross*' interactive

negotiation process.

　　　Schiavone also discloses a sender subsystem for initiating negotiation of a category and a

receiver subsystem for providing the sender subsystem with the listing of categories [0026, 0064,

0066] however *Schiavone* does not expressly disclose that the sender and receiver subsystems

are included in the negotiation module. However, the concept of distributing different

functionalities between different network elements, such as from a sender to a sender's

intermediary, is well known and obvious. *Schiavone* does disclose that his system can be

implemented by spreading out different functionalities to multiple third party intermediaries

[0066]. Thus, it would have been obvious to one of ordinary skill in the art to have implemented

Schiavone with a sender intermediary subsystem to perform the sender's responsibilities.

Claim 25

　　　Schiavone discloses said sender subsystem having access to a listing of sender categories

and is operative to deduce the category from the listing of categories maintained by the

negotiation module and the listing of sender categories [0026, 0062 : "list of shared specifiers" :

also see the rejection of claim 21].

Claim 26

Schiavone discloses the category is a common category belonging to the listing of sender

categories and the listing of categories maintained by the negotiation module [0026 : also see the

rejection of claim 21].

Claims 27 and 28

Schiavone does not discloses the category belonging to one of the two listings and is

mapped or is a new category to a second category belonging to the other of the two listings.

However, such as feature was well known in the art at the time of Applicant's invention. For

example, *Gross* discloses the feature. Specifically, *Gross* discloses selecting a category from a

receiver listing and mapping it (of adding a new category) to a sender listing and allowing the

sender to use the category specified by the receiver listing [0010, 0217]. It would have been

obvious to one of ordinary skill in the art to have modified *Schiavone*'s email system to include

Gross' teachings of mapping new categories to a sender. Enabling the receiver to specify the

categories used by the sender gives a receiver more control over the categories that may be used

by the sender.

Claim 29

Schiavone discloses the message exchange system further includes a plurality of

receiving subsystems for receiving the message for a plurality of receivers [0065], said

negotiation module further including a plurality of receiver subsystems, each of said plurality of receiver subsystems being operative to provide said sender subsystems with an indication that the category is recognized by each receiver subsystem [0026, 0066 : the recipient compliance engine as part of the negotiation module | see rejection of claim 14].

Claim 30

Schiavone discloses establishing a common category for a subset of said plurality of receivers and to associate said common category with the message for said subset of receivers [0055].

Claim 31

Schiavone discloses the use of one or more intermediary subsystems, said one or more intermediary subsystems having access to at least a separate listing of additional categories, and wherein the category is identified from a union of said separate listing of additional categories and the listing of categories [0026 : see rejection of claim 21 with respect to the concept of a "common set." Adding "additional categories" would have been obvious to one of ordinary skill in the art because a "common set" can refer to the union of multiple sets of items].

Claims 32 and 34

Schiavone discloses one of said one or more intermediary subsystems is selected by said receiver subsystem or sender subsystem [0030 – selecting a trusted authority]. *Schiavone* does not expressly disclose that the subsystems select the authority. However, such a feature is implied by *Schiavone*'s teaching that the sender and receiver have a shared common set of specifiers. This teaching implies that the sender and receiver have selected an intermediary to which to send their set of specifiers.

Claim 33

Schiavone does not expressly disclose a search module for searching for an selecting said one or more intermediary subsystems. However, such a feature is implied by *Schiavone*'s teachings that there can be more than one intermediary subsystem [0066 : trusted authority and/or another third party]. Since there are multiple intermediaries in *Schiavone*'s system, it would have been obvious to one of ordinary skill in the art to have reasonably inferred the use of a method to search and select from one of the multiple intermediaries.

Claim 35

Schiavone discloses presenting to a sender the listing of categories for the sender to select the category therefrom [0025 – menu].

Claim 36

Schiavone discloses said negotiation module is configurable through the user interface to either negotiate the category free of interactive input from the sender or to receive an indication of the category from the sender through the user interface [0025 – sender selects a specifier].

Claim 43

As to claim 43, *Schiavone* discloses obtaining the listing of categories includes:

obtaining a first listing of a first plurality of categories from a first intermediary, retrieving a second list of a second plurality of categories from a storage location maintained by said receiver subsystem, producing the listing of categories from a union of the first listing and the second listing [0026, 0064]. *Schiavone* discloses that the listing of categories is a result of shared "knowledge of a common set of message type specifiers". The term "common set" is well known to refer to a set of items in common between two different sets. Thus, it would have been

obvious for one of ordinary skill in the art to have reasonably inferred from *Schiavone*'s use of the term "common set" that the listing of categories was a result of a union of message type specifiers provided by the sender and the third party. Additionally, *Schiavone* discloses the receiver storing public preference data at the recipient's data store while the sender retrieves categories from a trusted intermediary.

Claim 47

Schiavone discloses a method of transmitting a message to a receiver for a sender in a message exchange system, the sender having a sender subsystem for sending the message and the receiver having a receiver subsystem for receiving the message, the sender subsystem having access to a listing of categories recognized by the receiver subsystem [see rejection of claim 14], the method comprising:

obtaining a destination address from the sender for identifying the receiver [0023 – use of an the receiver's email address];

receiving information from the sender to be included in the message [0025 – specifier based on content];

the sender subsystem negotiating a category with the receiver subsystem, the category being identified by the sender subsystem based on the information and the listing of categories [0026];

associating negotiated the category with the message [0025]; and

transmitting the categorized message to the receiver subsystem, the message being associated with the category [0024, 0025],

wherein the step of negotiating includes at least the substeps of communicating the category to the receiver subsystem [*Gross,* 0263], receiving an response from the receiver subsystem whether the category is recognized by the receiver subsystem and either adopting the category as a negotiated category if the category is acceptable or, if the category is not acceptable, negotiating with the receiver subsystem by proposing an alternative category to the receiver subsystem and adopting the alternative category as the negotiated category if the alternative category is acceptable to the receiver subsystem [*Gross,* 0263: receiver may accept or reject the proposed category, 0268: sending an indication to the sender to recategorize a message according to newly accepted categories].

Schiavone does not expressly disclose the negotiating substeps However, these substeps were well known in the art at the time of Applicant's invention.   See the rejection of claim 14 for reasons to modify *Schiavone* to include *Gross'* interactive negotiation process.

Claims 48-51

As to claims 48-51, as they do not teach or further define over the limitations of claims 15-17 and 20, claims 48-51 are rejected for at least the same reasons set forth for claims 15-17 and 20.

Claims 55 and 56

Schiavone discloses inserting an indication of the category in a section or header of the message [0024].

II.   CLAIMS 18, 19, AND 44-46 ARE REJECTED UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER *SCHIAVONE* AND *GROSS*, IN VIEW OF *SCHIAVONE* ET AL, U.S PATENT PUBLICATION NO. 20020120748 [*"KOENIG"*].

It should be noted that *Koenig* describes additional aspects of *Schiavone*'s invention. *Schiavone* makes explicit reference to the *Koenig* application [0068 : "Selective Delivery and Forwarding of Electronic Mail"]. Therefore, it would have been clear to one of ordinary skill in the art to have incorporated *Koenig* and *Schiavone* together to fully realize *Schiavone*'s invention.

Claims 18, 19, 45, and 46

As to claims 18 and 19, *Schiavone* does not expressly disclose storing or indexing the message according to the negotiated category. However, describing an additional aspect of *Schiavone*'s email system, *Koenig* discloses using the message specifiers (or identifiers) to store and index a copy of the categorized email messages in a categorized inbox [0039 : specifiers including "personal", "business"].

As to claims 45 and 46, as they do not teach or further define over the limitations of claims 18 and 19, claims 45 and 46 are rejected for at least the same reasons set forth for claims 18 and 19.

Claim 44

Schiavone does not expressly disclose storing the categorized message together with an indication of the category associated therewith. However, *Koenig* describes this aspect of *Schiavone*'s invention [0039].

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-

3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Primary Examiner, Art Unit 2452